

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-33 are pending and at issue. Claim 1 has been amended to recite the term “comprising” instead of “in which”, to remove the phrase “which may insignificantly dissolve the color reactant” and to recite each step in the gerund form.

Claim 5 has been amended to recite the multiple dependency in the alternative.

Claims 8, 10, 11, 14, 15, 17, 18, 20, 21, 23, 25, 26, 28, 32 and 33 have been amended to remove multiple dependencies.

Claims 10, 11, 19, 22 and 30-32 have been amended to remove the double numerical ranges.

Claims 11 and 20 have been amended to recite the term “comprising”.

Claim 17 has been amended to correct the antecedent basis.

Claim 18 has been amended to remove the term “in addition to”.

Support for these amendments are found in the claims as originally filed and in the specification at page 1 lines 9-14 and page 11, lines 11-17. No new matter has been added.

Claim Objections

Claims 8-33 are objected to for being in improper form, namely that these claims are multiple dependent claims that depend on other multiple dependent claims. Claims 8, 10, 11, 14, 15, 17, 18, 20, 21, 23, 25, 26, 28, 32 and 33 have been amended to remove multiple dependencies. Thus, this objection has been obviated.

Applicants respectfully request examination of the amended claims on their merits.

Claim 5 is objected to for reciting the multiple dependency in the cumulative. Claim 5 has been amended to recite the multiple dependency in the alternative. Thus, this objection has been obviated.

Information Disclosure Statement

As requested by the Examiner, a new list of disclosed references (PTO/SB/08) is submitted herewith with the corrected country codes for foreign patent documents BB and BC. Thus, this objection has been obviated.

Claim Rejection under 35 U.S.C. § 102(b)

Claims 1-7 stand rejected as anticipated by European Patent Application EP 0 718 116 A2 to Ito ("Ito"). The Examiner contends that Ito teaches all the limitations of claim 1, namely dissolving a color reactant in a vegetable oil solvent, mixing into the solution a non-dissolver and emulsifying the solution in the aqueous phase followed by encapsulation.

Applicants respectfully traverse this rejection and request reconsideration.

Ito does not disclose each limitation of claim 1. Claim 1 calls for a solvent that is a vegetable oil C₁-C₈ alkyl ester. The alkyl ester is formed upon esterification or transesterification of a vegetable oil with an appropriate alcohol. See the specification at page 3, lines 6-12. Although Ito teaches the use of a vegetable oil as a solvent, Ito does not disclose the use of a C₁-C₈ alkyl ester of that vegetable oil. See page 2, lines 31-32 of Ito. Since Ito does not disclose the use of a vegetable oil C₁-C₈ alkyl ester, Ito does not teach all of the limitations of claim 1.

For the foregoing reason, Ito fails to anticipate claim 1. Since claims 2-7 depend on claim 1, they are allowable for at least the same reason. Accordingly applicants respectfully request withdrawal of this rejection.

Claim Rejection under 35 U.S.C. § 103(a)

Claims 1-7 are rejected as obvious over U.S. Patent No. 4,748,146 to Pietsch (“the ‘146 Patent”) in view of Ito. The Examiner contends that the ‘146 Patent teaches dissolving a color reactant in a solvent, mixing into the solution a non-dissolver and emulsifying the solution followed by encapsulation. The Examiner contends that Ito discloses using a vegetable oil C₁-C₈ alkyl ester as a solvent, and that it would have been obvious at the time the invention was made to add the solvent disclosed in Ito to the process of the ‘146 Patent.

Applicants respectfully traverse this rejection and request reconsideration.

The present rejection is not well founded because there would have been no motivation that would have lead one of ordinary skill in the art to have combined the teachings of the ‘146 Patent and Ito.

The ‘146 Patent is directed to a method comprising dissolving a color reaction system in a solvent to produce a solution, followed by the addition of a non-solvent to produce a supersaturated system. It is this supersaturated solution that is encapsulated. See the ‘146 Patent, column 2, lines 44-47. Ito, however, is directed towards the addition of a bisphenyl compound which enhances the dissolution of Crystal Violet Lactone (“CVL”) in vegetable oil, creating a non-supersaturated solution. See Ito, page 5, lines 10-14. It is this non-saturated solution that is then encapsulated. See Ito, page 8, lines 22-25 and 28-30. Since the solubility of a solute is dependent upon the solvent, it would not have been obvious to one skilled in the art to use the solvent of Ito, used for producing a non-supersaturated solution, in the process of the ‘146 Patent, which calls for

the production of a supersaturated solution. Therefore, there is no motivation for combining the teachings of the '146 Patent and Ito.

Without the teaching of Ito (which as described above does not disclose the use of a C₁-C₈ alkyl ester of vegetable oil as called for in claim 1), the '146 Patent does not teach or suggest the use of a C₁-C₈ alkyl ester of vegetable oil as the solvent. Accordingly, a *prima facie* case of obviousness can not be established. M.P.E.P. 2143.03. As disclosed in the present specification, the use of a C₁-C₈ alkyl ester of vegetable oil as the solvent leads to unexpected advantages over other solvents. Writing performance has improved significantly for systems using a C₁-C₈ alkyl ester of vegetable oil as the solvent in comparison to systems that do not use a C₁-C₈ alkyl ester of vegetable oil as the solvent. See page 12, line 16-page 13, line 2 of the specification. For this reason it is respectfully submitted that the use of a C₁-C₈ alkyl ester of vegetable oil as the solvent is not obvious in view of the '146 Patent.

For the foregoing reason, claim 1 is not obvious over the teachings of the '146 Patent and Ito. Since claims 2-7 depend on claim 1, they should be allowable for at least the same reason. Accordingly, applicants respectfully request withdrawal of this rejection.

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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